IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	**Jeffry Jovan Philyaw**
Application Serial No.:	**09/494,924** **Confirmation No.: 4127**
Filing Date:	**February 1, 2000**
Group:	**3627**
Examiner:	**Christopher R. Buchanan**
Title:	**INPUT DEVICE FOR ALLOWING INTERFACE TO A WEB SITE IN ASSOCIATION WITH A UNIQUE INPUT CODE**

APPELLANT'S REPLY BRIEF

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APPELLANT'S REPLY BRIEF

This Reply Brief is submitted in accordance with 37 C.F.R. § 41.41 concerning the Examiner's Answer mailed November 23, 2007 in response to the Appellant's Brief on Appeal dated June 20, 2007, that was filed concerned the Notice of Appeal filed November 20, 2006 in response to the Examiner's Final Office Action, dated May 18, 2006, wherein the Examiner finally rejected claims 22-27 that comprise all of the pending claims in this application.

I. Status of the Claims.

Claims 22-27 from the application are pending, stand firmly rejected, and are on appeal here.

II. Grounds of Rejection to be Reviewed on Appeal.

Claims 22-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,978,773 to Hudetz et al. ("*Hudetz*") in view of U.S. Patent No. 6,577,861 to Ogasawara ("*Ogasawara*") and U.S. Patent No. 6,078,321 to Simonoff et al. ("*Simonoff*"), and also in view of comments made by Appellant during prosecution.

As detailed below, the Examiner has improperly applied the combination of *Hudetz* in view of *Ogasawara* and *Simonoff* references to claims 22-27. Appellant will focus on two specific areas that are not supported by this combination of references and, as such, it is Appellant's position that the Examiner has failed to state a *prima facie* case as to the combination of *Hudetz* in view of *Ogasawara* and *Simonoff* constituting a viable combination of references under 35 U.S.C. § 103 to fully obviate Appellant's invention.

III. Argument and Discussion.

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A. 35 U.S.C § 103 Rejection in the Application on Appeal.

In the Examiner's Brief, dated November 23, 2007, the Examiner stated:

> The appellant argues that the examiner has improperly applied the combination of the Hudetz, Osasawara, and Simonoff references in the rejection of claims 22-27 and that the examiner has not provided a *prima facie* case in the rejection of the claims under U.S.C 103. In particular, the appellant argues (p. 7 of brief) that the examiner does not provide a proper motivation for combining the prior art references, that the references do not constitute analogous art, and that all of the claimed limitations are not shown by the references.
>
> The examiner disagrees and stands by the rejection. In the rejection above, each claimed limitation is clearly addressed and when prior art is used to show the claimed limitation the relevant location in the reference is provided. Furthermore, clear motivation is provided for combining the teachings of different references in each instance of combination in the rejection above. Lastly, in the examiner's view, the Hudetz, Osasawara, and Simonoff references do constitute analogous art. The Hudetz patent (classified in 705/23) discloses a system in which a local input device (barcode scanner and computer) is used to scan a product code to identify a product and access a remote database to gather information on the product using the product ID. The Ogasawara patent (cross referenced in 705/26) discloses a system in which a local input device (barcode scanner and wireless phone) is used to scan a product code to identify a product, to access a remote server to gather information on the product using the product ID, and to purchase the product. The Simonoff patent (classified in 345/335) discloses a method for connecting and operating two different computers with varying architectures that are connected by a network, wherein messages are sent between the computers along with a unique ID. In the examiner's view, the above mentioned references and the instant invention are related to a common topic, i.e., connecting two geographically separated computers and sending data between them, thus the prior art references constitute analogous art with the instant invention.[1]

[1] See Examiner's Brief mailed November 23, 2007, pages 7 and 8, section 10.

In the Appeal Brief, Appellant argued that the combination provided is improper in light of the TSM test.[2] Despite the arguments enumerated in the Appeal Brief, no teaching, suggestion or motivation has been provided, and no articulated reasoning, with some rational underpinning, to support the conclusion of obviousness has been provided. Therefore, a conclusion of obviousness is improper. As such, the Examiner's combination of *Hudetz* in view of *Ogasawara* and *Simonoff* is merely conclusory.

1. Independent Claim 22 as rejected by the combination of *Hudetz* in view of *Ogasawara* and *Simonoff*.

In the Examiner's Brief mailed November 23, 2007, the Examiner maintains his 35 U.S.C. § 103 rejection of Claims 22-27. On page 4 of the Final Office Action the Examiner restates the rejection based on the combination of *Hudetz* in view of *Ogasawara* and *Simonoff*.

The Examiner states that "[i]n the rejection above, each claimed limitation is clearly addressed and when prior art is used to show the claimed limitation the relevant location in the reference is provided"[3] and that "clear motivation is provided for combining the teachings." Without conceding the propriety of the asserted combination, the Examiner has failed to provide a combination that teaches each and every element, expressly or inherently, recited in Independent Claim 22.

The substance of the Examiner's rejection has been discussed in detail in Appellant's Appeal Brief and only the specific issue of the unique ID and the use thereof will be discussed in this Reply Brief.

The Examiner has relied on *Hudetz* as a primary reference. The following Claim Chart illustrates how the Examiner is applying *Hudetz*:

Independent Claim 22	*Hudetz* is provided to teach[4]:
Claim 22: **A method for interconnecting a first location on a global communication network with a second location thereon,**	**Hudetz et al. also disclose** in response to the step of scanning and the step of associating, **connecting the first location to the second location**

[2] See Appeal Brief filed June 20, 2007, pages 38 – 41.
[3] See Examiner's Answer, mailed November 23, 2007, pages 6 and 7, section 10.
[4] See Examiner's Answer mailed November 23, 2007, pages 4 and 5, section 9.

comprising the steps of:	
providing an input device coupled to the first location on the global communication network, the input device having associated therewith a unique input device ID that is permanently associated with the input device and independent of the first location;	Regarding claim 22, Hudetz et al. disclose **providing an input device (28, 44, i.e., computer and barcode reader) at the first location on the global communication network**
scanning a product code disposed on a product with the input device, which product code is representative of the product in commercial transactions, the step of scanning operable to extract the information contained in the product code to provide a unique value as an output;	Regarding claim 22, Hudetz et al. disclose **providing an input device (28, 44, i.e., computer and barcode reader) at the first location on the global communication network**
associating the unique value with the unique input device ID in a message packet, such that the unique input device ID is associated with the message packet for transmission over the network and wherein the second location has a predetermined association with the combination of the unique value and the unique input device ID, such predetermined association associates the second location with both the unique device ID and the unique value; and	
in response to the step of scanning and the step of associating, connecting the first location to the second location.	**Hudetz et al. also disclose in response to the step of scanning and the step of associating, connecting the first location to the second location** (col. 11 lines 4-10, once the unique value, i.e., the numeric address encoded in the bar code is extracted, it is associated by the service provider with the first location computer.)

The Examiner did not indicate that *Hudetz* provided support for the "unique ID being unique to the scanning device and permanently associated therewith independent of location." The Examiner erroneously relies upon Appellant's comments to cure this deficiency in the teachings of *Hudetz*, as set forth in the following Claim Chart and discussion:

Independent Claim 22	*Hudetz* is provided to teach:	Examiner's reliance on Appellant's comments
Claim 22: A method for …, comprising the steps of:		
providing an input device coupled to the first location on the global communication network, the input device having associated therewith a unique input device ID that is permanently associated with the input device and independent of the first location;	Regarding claim 22, Hudetz et al. disclose **providing an input device (28, 44, i.e., computer and barcode reader) at the first location on the global communication network**	**having associated therewith a unique input device ID** (the address of every computer is notoriously well know *(sic)* to be transmitted by a PC to a server); notwithstanding, *since applicant admits that the computer (28) does indeed have its own address then, because the computer also has an input device (44), then the computer is read as an input device having an input ID.*
scanning a product code disposed on a product … to provide a unique value as an output;		
associating the unique value with the unique input device ID in a message packet, …., such predetermined		

association associates the second location with both the unique device ID and the unique value; and		
in response to the step of scanning … the first location to the second location.		

However, the Examiner's assertion that "*applicant admits that the computer (28) does indeed have its own address then, because the computer also has an input device (44), then the computer is read as an input device having an input ID*" is clear error. In the Response to the Office Action, mailed August 23, 2003, Appellant states "[n]owhere is it disclosed, taught or suggested in *Hudetz* that the input device (44) has 'associated therewith a unique input device ID.' Further, the local host computer (28) in *Hudetz* may indeed have its own address but such address would not then be the unique input device ID associated with the input device of the Applicant's claimed invention, which input device is distinct from a computer to which the input device is connected."[5] In response to the Examiner's contention that this was an admission by Appellant and that *the computer is read as an input device having an input ID*,[6] Appellant stated "[a]lthough Applicant admits that every computer will have a known device ID, i.e., the ID of the network interface card, there is no association between the ID of the network card and any location on the network. It is this association in a database that allows routing of a user location to a second location on a network in association with the product code. Therefore, there must be an association between the product code, the unique device ID and the second location of the network in order to have routing to the second location in response to the step of scanning. This is neither disclosed nor suggested in *Hudetz et al*. Further, the unique ID cannot in *Hudetz* follow the scanner from computer to computer."[7] Appellant provided repeated support that the computer ID in *Hudetz* cannot be utilized as a unique ID for an input device. Additionally,

[5] See Response to Office Action mailed August 23, 2002, page 3.
[6] See Office Action, mailed June 13, 2003, page 2.
[7] See Response to Office Action, mailed October 18, 2003, pages 4 and 5.

Appellant argues why the NIC ID of the computer is not the type of unique ID required the by the claims of the instant application.[8] However, the Examiner has provided no support for his contention. The Examiner has completely mischaracterized Appellant's statements and provided no support for his conclusions. To rely on the NIC address of a computer to support a rejection of the claims by stating that it is "notoriously well known" is not sufficient to define how such a NIC address can function in the way that the unique scanner ID does in accordance with the claimed limitations. For example, a NIC address is a source identifier of the computer whenever a packet is placed on the network. This is used for communication on an Ethernet system. The Ethernet standard rigidly defines how this address is used. Since the address is "stripped" from the data packet by the MAC layer upon receipt, there is no way the NIC address could be in any way used for any later association with a "second" location in an associative database. This is a question that needs to be addressed and the Examiner has provided no support for his contention nor did the Examiner contend that Appellant's position was incorrect with respect to how the NIC address was used. Without additional support, the Examiner's statement that *Hudetz* provides a scanning device that has a unique ID associated therewith without providing support for such is clear error.

The Examiner then provides *Ogasawara* as a secondary reference to cure the deficiencies of *Hudetz*. The Examiner's position is stated in the following Claim Chart:

Independent Claim 22	*Ogasawara* is provided to teach[9]:
Claim 22: A method for interconnecting …., comprising the steps of:	
providing an input device coupled to the first location on the global communication network, **the input device having associated therewith a unique input device ID that is permanently associated with the input device and independent of the first location**;	Hudetz et al. fail to disclose the input device ID permanently associated with the input device and independent of the first location. **Ogasawara discloses such a permanently associated ID telephone number (col. 10 lines 1-41).** It would be obvious to modify the method of Hudetz et al. to include such an ID, as taught by Ogasawara, because it would

[8] See Appeal Brief, page 27.
[9] See Examiner's Answer mailed November 23, 2007, pages 4 and 5, section 9.

	allow the input device to be free of a base station.
scanning a product code … to provide a unique value as an output;	
associating the unique value with the unique input device ID in a message packet, such that the unique input device ID is associated with the message packet for transmission over the network and wherein the second location has a predetermined association with the combination of the unique value and the unique input device ID, such predetermined association associates the second location with both the unique device ID and the unique value; and	In addition to this, Ogasawara discloses (col. 10 lines 43-46) that **each message coming from a wireless telephone (18) is associated with the customer's telephone number, customer ID or some other unique identifier.**
in response to the step of scanning and the step of associating, connecting the first location to the second location.	

Additionally, the Examiner provides *Simonoff* as a tertiary reference to cure the deficiencies of the *Hudetz-Ogasawara* combination. *Simonoff* is applied as follows:

Independent Claim 22	*Simonoff* is provided to teach[10]:
Claim 22: A method for …, comprising the steps of:	
providing an input device coupled to the first location …;	
scanning a product code disposed on a …;	

[10] See Examiner's Answer mailed November 23, 2007, pages 4 and 5, section 9.

associating the unique value with the unique input device ID in a message packet, such that the unique input device ID is associated with the message packet for transmission over the network and wherein the second location has a predetermined association with the combination of the unique value and the unique input device ID, such predetermined association associates the second location with both the unique device ID and the unique value; and	Additionally, Hudetz et al. fail to disclose the unique ID is associated with a message packet. Simonoff et al. disclose (col. 11 lines 13-68) disclosed **a unique ID which is commonly associated with a message (value) between different locations.** It would further be obvious to modify the aforesaid combination to include the unique ID commonly associated with a value between two locations, as taught by Simonoff et al., the motivation being the ability to communicate between differently designed systems.
in response to the step of scanning and the step of associating, connecting the first location to the second location.	

However, *Hudetz*, *Ogasawara*, and *Simonoff*, taken singularly or in combination, do not disclose all the limitations of independent Claim 22.

Independent Claim 22	No support provided for:
Claim 22: A method for … comprising the steps of:	
providing an input device coupled to the first location on the global communication network**, the input device having associated therewith a unique input device ID** that is permanently associated with the input device and independent of the first location;	**the input device having associated therewith a unique input device ID**
scanning a product code … a unique value as an output;	
associating the unique value with the unique input device ID in a message packet, such that the unique input device ID is associated with the message packet for	**associating the unique value with the unique input device ID in a message packet**

transmission over the network	
and **wherein the second location has a predetermined association with the combination of the unique value and the unique input device ID, such predetermined association associates the second location with both the unique device ID and the unique value**; and	**wherein the second location has a predetermined association with the combination of the unique value and the unique input device ID, such predetermined association associates the second location with both the unique device ID and the unique value**
in response … connecting the first location to the second location.	

Appellant shows that the combination of *Hudetz* and *Ogasawara* does not disclose the input device having associated therewith a *unique input device ID that is permanently associated with the input device* and independent of the first location.[11] The telephone number in *Ogasawara* is neither permanent nor an ID of the type that can be used in a manner as required by the claims of the instant application. Further, the claims require that the association is with a second location. Thus, how can a NIC address of a computer which defines only a source address in any way function to have a relationship with second location wherein that relationship is predetermined? The Examiner has provided no support in the references for the limitation wherein there is provided a scanning device with a unique ID and there is a step of *associating the unique value with the unique input device ID in a message packet* which association is a predetermined association. Appellant has shown that *Simonoff* does not teach associating a unique value with the unique ID of the input device in a message packet as required by the claims of the instant application[12] and there is no showing that a unique ID is permanently associated with the input device, which unique ID can then be transmitted in a message packet with the unique value. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of *Hudetz*, *Ogasawara*, and *Simonoff* is likewise deficient, even in view of the knowledge of one of ordinary skill in the art. Additionally, the asserted combination fails to teach a second location on a network that has a predetermined

[11] See Appeal Brief, pages 31-35 and page 38.
[12] See Appeal Brief, pages 37-39.

association with a combination of a unique value and a unique device ID.[13] Further, the Examiner has failed to provide a reference to teach *wherein the second location has a predetermined association with the combination of the unique value and the unique input device ID, such predetermined association associates the second location with both the unique device ID and the unique value.*

The Examiner has provided no support or explanation why the differences in the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The Examiner's reliance on the asserted combination to teach the above identified elements is clear error.

The Examiner states that "clear motivation is provided for combining the teachings of different references in each instance of combination in the rejection above."[14] Even if the references are found to be analogous, which Appellant contends they are not, the Examiner has not provided a motivation to combine the references. The Examiner agrees that *Hudetz* is deficient. The Examiner contends that "Hudetz et al. fail to disclose the input device ID permanently associated with the input device and independent of the first location [but] Ogasawara discloses such a permanently associated ID telephone number (col. 10 lines 1-41)."[15] First, Appellant shows that *Hudetz* teaches away from the concept of an input device ID.[16] As such, any asserted combination to provide an input device ID contravenes the teaching in *Hudetz*. Second, the Examiner provides, as reasoning for the combination, that "[i]t would be obvious to modify the method of Hudetz et al. to include such an ID, as taught by Ogasawara, because it would allow the input device to be free of a base station."[17] The Examiner has provided no other reasoning "why" one skilled in the art would use a scanner attached to a wireless phone, as taught by *Ogasawara*, to scan a product code on a product in order to retrieve an HTML document containing a list of associated URLs, as taught by *Hudetz*. However, the reasoning submitted by the Examiner suggests a hindsight bias and is in clear error. Using the combination of *Hudetz* and *Ogasawara*, a user would scan an article of commerce, transmit the information

[13] See Appeal Brief, pages 39-40.
[14] See Examiner's Answer, mailed November 23, 2007, pages 6 and 7, section 10.
[15] See Examiner's Answer, mailed November 23, 2007, pages 4 and 5, section 9.
[16] See Appeal Brief, pages 28 and 29.
[17] See Examiner's Answer, mailed November 23, 2007, pages 4 and 5, section 9.

via the wireless phone to a computer, only to have to physically access the computer to then select the URL associated to the information the users wishes to view at the computer. The question is why would someone, wanting to enter a URL, want to be free of the base station, using a telephone communication to access the base station, which they had to subsequently access to find the information they were seeking? The Examiner has not provided a motivation that would cause one skilled in the art to combine the teachings of *Hudetz* and *Ogasawara*.

Further, the Examiner combines *Hudetz* and *Ogasawara* with *Simonoff*. The Examiner states:

> Additionally, Hudetz et al. fail to disclose the unique ID is associated with a message packet.
>
> Simonoff et al. disclose (col. 11 lines 13-68) disclosed a unique ID which is commonly associated with a message (value) between different locations.
>
> In addition to this, Ogasawara discloses (col. 10 lines 43-46) that each message coming from a wireless telephone (18) is associated with the customer's telephone number, customer ID or some other unique identifier.
>
> It would be obvious to include a unique ID associated with a message in the method of Hudetz et al., as taught by Ogasawara, because this would insure that the message packet would be routed to the assigned device through whatever route is possible."[18]

The Examiner provides, as a rationale for the asserted combination, that it would have been obvious for one skilled in the art "to modify the aforesaid combination to include the unique ID commonly associated with a value between two locations, as taught by Simonoff et al., the motivation being the ability to communicate between differently designed systems."[19] However, the Examiner has provided no reasoning "why" one skilled in the art, with the teachings of *Hudetz* and *Ogasawara* in front of them, would seek to modify the telephone communication system of *Ogasawara* and the network accessing system of *Hudetz* with the software ID of *Simonoff* to enable *Hudetz-Ogasawara* to communicate between differently designed systems. Both *Hudetz* and *Ogasawara* teach systems that establish a dedicated communication link with other systems, and wherein information is accessed at a first location and transmitted to a second location that includes a database for using the information accessed

[18] See Examiner's Answer mailed November 23, 2007, pages 4 and 5, section 9.
[19] See Examiner's Answer mailed November 23, 2007, page 5, section 9.

at the first location. The Examiner has provided no articulated reasoning or explicit analysis as to "how" or "why" such combination would be accomplished. [A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.[20] The Examiner has fallen prey to hindsight bias and is reading into the prior art the teachings of the invention in issue.[21]

Further, the Examiner provides, as a rationale for the asserted combination, that "[i]t would be obvious to include a unique ID associated with a message in the method of Hudetz et al., as taught by Ogasawara, because this would insure that the message packet would be routed to the assigned device through whatever route is possible."[22] This position is inconsistent with the fact that the NIC address is a source address that has nothing to do with routing – it merely is an identifier of the source. Further, *Hudetz* teaches that a user sets up the system such that the system accesses a specific database. *Ogasawara* teaches that the scanner connects to a specific location via a wireless telephone connection. As such, neither reference suggests, nor is in need of, another method to ensure that the message packet would be routed to the assigned device through whatever route is possible. Both *Hudetz* and *Ogasawara* teach a dedicated route is established. As such, the Examiner provides no support that there existed a known problem, as described, that required the asserted combination.

The Examiner has provided references that teach individual elements of the claim of the instant application, that of a scanner, an ID used in association with the scanner (though not permanent), and an ID used in a message packet (assigned by a server as a destination address and also not permanent). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole."[23] Rather, the Examiner merely states that one of ordinary skill in the art would have been motivated to combine these references to allow an input device to be free of a base station, to be able to communicate between differently designed systems, and to insure that the message packet would

[20] *KSR*, 127 S. Ct. at page 1742
[21] *KSR*, 127 S. Ct. at page 1742, warning against a "temptation to read into the prior art the teachings of the invention at issue" and instructing … to "guard against slipping into the use of hindsight."
[22] See Examiner's Answer mailed November 23, 2007, pages 4 and 5, section 9.
[23] *Kahn,* 441 F.3d at 986, citing *Rouffett*, 149 F.3d at 1355, 1357

be routed to the assigned device through whatever route is possible.[24] However, the Examiner's assertions do not teach all the elements recited by the claims of the instant application and are clear error. The Examiner has provided no teaching, suggestion or motivation why the asserted combination would be obvious to one of ordinary skill in the art so as to render obvious Claims 22-27 of the instant application.

[24] See Examiner's Answer mailed November 23, 2007, pages 5, section 9.

IV. Conclusion

In Summary, Appellant submits that the Examiner's assertions are clear error. The Examiner has not provided a rationale to support a conclusion of obviousness. Further, the Examiner has not provided an articulated reasoning to illustrate "why" one skilled in the art would combine the references in the particular manner required to provide a predictable variation. Instead, the Examiner simply identifies particular components for each reference, combines them in a specific manner required by Appellant's claimed invention, and then states that it would be obvious to one skilled in the art to do so. This is clearly hindsight based reasoning that contravenes the standards imposed by the MPEP, The Examination Guidelines and the Federal Circuit, and Appellant respectfully submits that the cited combinations are improper for reasons detailed above and requests that the rejections under § 103 be withdrawn.

Respectfully submitted,

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